

**Mail Stop Appeal Brief – Patents**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In Re: Patent Application of Charles Eldering et al.**

Conf. No.: 2970	:	Group Art Unit: 3622
Appln. No.: 09/591,577	:	Examiner: Retta, Yehdega
Filing Date: 9 JUNE 2000	:	Attorney Docket No.: T702-03
Title: Privacy-protected Advertising System		

**APPELLANTS' REPLY BRIEF TO THE EXAMINER'S ANSWER**

In response to the Examiner's Answer dated April 27, 2009, and further to the Appeal Brief filed January 12, 2009, Applicants hereby submit a Reply Brief in accordance with 37 C.F.R. §41.41 for the above-referenced application.

This Reply Brief is being filed in response to Examiner's Answer, dated April 27, 2009 (Examiner's Answer). All of the arguments and remarks set forth in Appellants' Appeal Brief filed January 12, 2009 (Appeal Brief) are incorporated herein by reference.

### **RESPONSE TO EXAMINER'S ARGUMENTS**

#### **Rejection under 35 U.S.C. § 103 to Claim 133**

##### **1. Hendricks Does Not Teach a "psychological or sociological study"**

The Examiner argues that, "the psychological or sociological study is understood to mean a behavioral study," and, in the Examiner's Answer – for the first time – supplies a definition from Encarta Encyclopedia to support her contention. (See Examiner's Answer, p. 7). On the contrary, Applicants respectfully submit that the supplied definition actually shows that there is a strong distinction between a psychological study and the behavioral element allegedly taught in Hendricks. Thus, the Examiner's definition actually supports Applicants' position.

As set forth in the Appeal Brief, "a study based on behavior is simply not equivalent to a psychological or sociological study," and, "a psychological study makes conclusions about an individual's psychology," not just their behavior. (Appeal Brief, pgs. 12 – 13). This reading is supported by the definition of psychology proposed by the Examiner. According to the Examiner the definition of psychology is, "the scientific study of behavior **and** the mind. **This definition contains three elements.**" (Examiner's Answer, p. 7, emphasis added). As such, even by the Examiner's definition, a behavioral study alone does not constitute a psychological study, since a behavioral study does not contemplate or incorporate any aspect related to one's mind. Hendricks, however, at most discusses *only* a behavioral element and does not discuss any study of the mind. Sociology is the study of society, and thus, an observation of behavior is not analogous to a sociological study. As such Hendricks does not teach a sociological study either.

Applicants also note that the Examiner has failed to respond to the fact that Hendricks does not teach a study at all. (See Appeal brief, p. 12). As supported by the Examiner's definition, psychology requires a "scientific study." (Examiner's Answer, p. 7). Using the same source the Examiner relies on for "psychological study," a search for

the term “scientific study” returns the definition of scientific method. “Scientific method” is defined as a “term denoting the principles that guide scientific research and experimentation” (See <http://encarta.msn.com/encnet/refpages/search.aspx?q=scientific+study>). This clearly supports Applicants’ position that a “study” requires more than a simple observation (e.g., the system of Hendricks). (Appeal Brief, pgs. 12 – 13). This exemplifies the clear difference between the unscientific comparison accomplished by Hendricks and the psychological or sociological studies recited in claim 133. A behavioral observation, like the system of Hendricks, does not adhere to the scientific method nor have the features necessitated by a “study.” Unlike Hendricks, which describes “an algorithm,” that “statistically compare[s] the viewer’s programs watched” to that of previous viewers, the psychological or sociological study of claim 133 uses a scientific study which adheres to the scientific method. A simple comparison cannot be viewed as a ‘study’ under any circumstances. (Appeal Brief, p. 12). Thus, since Hendricks does not teach or suggest this element, the proposed combination does not teach or suggest all elements of independent claim 133. (Appeal Brief, p. 12).

## **2. Hendricks, Ho and Pirolli are Not Properly Combinable**

The Examiner has failed to point to or otherwise establish an “apparent reason to combine the known elements in” Hendricks, Ho or Pirolli, and instead relies on a vague unexplained notion that one of ordinary skill in the art would have a desirability to combine these references. (Appeal Brief, P. 15). As stated in MPEP 2143.01 IV, a mere “statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness.” However, the Examiner has in fact done exactly this, and violated the clear requirements of the MPEP by not providing any detail to substantiate the proposed combination or obviousness rejection generally.

In the Examiner’s Answer, the Examiner argues that in regards to combining the references, the Examiner has stated a reason a person of ordinary skill in the art would have combined the prior art elements. (See Examiner’s Answer, p. 10). However, the

Examiner has never actually stated any such reason. The Examiner has consistently responded to Applicants' requests to substantiate the combination by stating, "Ho used heuristic rule to determine or predict unknown user's characteristics by statistics based on the preference of similar students (user behavior or action which a psychological or sociological study)." (See June Office Action, p.6). This is nothing more than a "conclusory statement" which fails to articulate reasoning "with some rational underpinning to support" the contention. (See MPEP 2143.01 IV *quoting KSR*). As such, the Examiner has not adhered to Supreme Court precedent regarding obviousness rejections.

Furthermore, regardless of the Examiner's failure to properly articulate grounds for the combination, Applicants respectfully submit that one skilled in the art would not look to Ho (directed to an educational tool) to modify the teachings of Hendricks (directed to a targeted video advertising system) to result in Applicants' claimed subject matter. Thus, such a proposed combination of Hendricks, Ho and Pirolli does not make "common sense." *See KSR v. Teleflex*, 550 U.S. 398 (2007). Accordingly, the proposed combination of Hendricks, Ho and Pirolli is improper.

### **3. Ho is Not Analogous Prior Art**

The Examiner argues that, "it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention." (Examiner's Answer, pgs. 10 – 11, *quoting In re Oetiker*, 944 F. 2d 1443 (Fed. Cir. 1992)). The MPEP, relying on *KSR*, states that, "a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." (MPEP 2141.01(a)). As discussed at length in the Appeal Brief, Ho is not in Applicants' field of endeavor and would not have commended itself to an inventor's attention. (See Appeal Brief, pgs. 16 – 17). The Examiner's only explanation for how Ho is analogous is that, "Ho used heuristic rule to determine or predict unknown user's characteristics by statistics based on the preference of similar students." (Examiner's Answer, p. 10). This does not describe how Ho would have "commended

itself to the inventor's attention." Therefore, Ho would not have "commended itself" to the inventor's attention, and is not analogous to or Applicants' application and/or claimed subject matter.

Ultimately, Applicants' previous arguments stand: the combination of Hendricks, Ho and Pirolli does not teach or suggest all elements of independent claim 133. Respectfully, the Examiner has misread Hendricks and has continuously failed to cite a reason for the combination of the prior art references. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claim 133.

#### Rejection under 35 U.S.C. § 103 to Claim 153

##### **1. The Proposed Combination Does Not Teach or Suggest All Claim Elements**

The Examiner argues that Ho teaches a "pre-defined heuristic rules have been developed through the application of at least one heuristic process which incorporates at least two types of analysis selected from the group consisting of logic tests, statistical estimates, self-learning, experiments, market studies, human knowledge and experience," by making two seemingly distinct arguments.

First, the Examiner uses a hand-picked definition of "heuristic" and contends that Ho teaches such a concept. Ho, however, is very explicit about what the heuristics in Ho include. In Ho, a reward, "can be heuristically determined by statistics based on the preferences of similar students ... such information can be found through market research." (Ho, column 7, lines 5 – 10). As such, it is improper to attribute "educated guesses, intuitive judgments and common sense" into Ho's process, when Ho so strictly defines the process. Quite simply, the rewards in Ho are "heuristically determined **by statistics,**" which are "**found through market research.**"

Next, the Examiner argues that "Ho's heuristic rule is developed based on at least two types of analysis; market research and statistics." (Examiner's Answer, p. 11). This argument makes little sense. The only "analysis" used in Ho is market research. The market research results are statistics. Essentially, Ho teaches one type of analysis in

specific terms; this cannot be viewed as two types of analysis. Accordingly, the proposed combination does not teach or suggest all elements of independent claim 153.

**2. Improper Combination / Non-analogous Art**

For the same reasons set forth above with respect to claims 133 – 139 and 152, the proposed combination of Hendricks, Ho, and Pirolli is improper and Ho is a non-analogous reference.

Applicants' previous arguments stand: the combination of Hendricks, Ho and Pirolli do not teach or suggest all elements of independent claim 153. Respectfully, the Examiner has misread Ho and has continuously failed to cite a reason for the combination of the prior art references. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claim 153.

**Conclusion**

Applicants respectfully submit that the Examiner's rejections have been previously overcome, and that the application, including of claims 133 – 139 and 152 - 159, is in condition for allowance. Applicants respectfully request that the Board reverse the Examiner's rejections of the claims and remand this application for issue.

Respectfully submitted,

Date: June 25, 2009 \_\_\_\_\_

By: /aws/\_\_\_\_\_

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